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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,209	09/09/2003	Toshiyuki Noguchi	00862.023227.	9145
5514	7590	12/13/2005		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER PATEL, MANGLESH M	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/657,209	Applicant(s) NOGUCHI, TOSHIYUKI	
	Examiner Manglesh M. Patel	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed on September 9, 2003.
2. Claims 1-14 are pending. Claims 1, 6, 9, 10, 11, 12, 13 & 14 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. JP 2002-268831, filed on September 13, 2002.

Drawings

4. The examiner has accepted the Drawings filed on September 9, 2003.

Claim Objections

5. Claims 11-12 & 14 are objected to because of the following informalities: The claims describe a program to execute a method defined in another method claim. It is unclear if the claims are a dependent or independent claim format. If the claim is an independent claim then it should contain the steps of the actual method claim and not a numerical reference. Otherwise they should all describe the same method if dependent claim format. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-7, 9-10 & 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims include the word "Can" thereby rendering the claims indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelley (U.S. 6,320,671, filed May 15, 1998).

Regarding Independent claim 1, Kelley discloses an information processing apparatus for processing information written in a language which can describe design of a window to be displayed by a browser, comprising:

- Reception means for receiving first list data transmitted from another apparatus connected through a network (column 1, lines

45-55, wherein the list data is represented by the printable web pages that are received from another apparatus through a network. The HTML source file contains the list of printable web pages thereby comprising information written in a language that describes the design of a window so the browser can display the source files representing the list data); and

- Storage means for storing a function expansion program for the browser, said function expansion program including acquisition unit adapted to acquire second list data and creation unit adapted to create the information for causing the browser to display a window based on the second list data acquired by the acquisition unit and the first list data received by said reception means (column 1, lines 55-67 & column 2, lines 1-5 & column 5, lines 5-10, wherein the browser is rendered in Netscape thereby inherently including the use of a function expansion program or plug-in. Since the printable web pages include different formats such as PDF, a plug-in would have to exist to support the rendering and printing in the browser of the document. In addition the client includes a plurality of lists thereby including an acquisition unit for receiving a second list supported by the Netscape browser using a plug-in).

Regarding Dependent claim 2, Kelley discloses wherein the function expansion program for the browser further comprises computation unit adapted to perform a set operation between the second list data acquired by the acquisition means and the first list data received by said reception means, and the creation unit creates on the basis of an operation result obtained by the computation unit (column 5, lines 5-10, wherein the browser is rendered in Netscape thereby inherently including the use of a function expansion program or plug-in. The plug-in is the computational unit that relates the list data so it is rendered and printed in the browser thereby forming a result).

Regarding Dependent claim 3, Kelley discloses wherein the apparatus can be connected to at least one printing apparatus through a network, and the acquisition means acquires the second list data on the basis of information obtained from at least one of an operating system and control software for the printing apparatus (See figure 1, wherein the connection includes a printing apparatus connected to a network. The acquisition includes receiving the second list data or web pages from the network server and database that include an operating system).

Regarding Dependent claim 4, Kelley discloses wherein the function expansion program for the browser further comprises second information creation means for creating the information for causing the browser to display an input window for

various conditions for printing processing executed by the printing apparatus on the basis of the first and second list data (column 5, lines 25-40, wherein the plug-in within the browser representing the function expansion program with the list data is used to render a window within the browser, including conditions for printing using a print list menu).

Regarding Dependent claim 5, Kelley discloses wherein each of the first list data and the second list data lists at least one of information about a model of the printing apparatus, information about a paper size for printing by the printing apparatus, information about a paper type for printing by the printing apparatus, and information about a layout for printing by the printing apparatus (column 2, lines 5-15, wherein the list data includes identification information of the printer thereby describing the model of the printer used to select a printer on a network).

Regarding Independent claim 6, Kelley discloses an information providing apparatus connected to a client apparatus through a network, comprising:

- Storage means for storing first list data to be used by a function expansion program for a browser in the client apparatus which stores the second list data (See figure 1 & column 4, lines 45-60, wherein the client device includes a database for storage of the list data representing the web pages and are inherently used by the

function expansion program representing the browser plug-in used to render certain web pages that are in different formats); and

- Transmission means for transmitting, through a network, at least one of information written in a language which can describe design of a window to be displayed by the browser and the first list data stored in said storage means in accordance with a request from the client apparatus (See figure 1 & column 1, lines 45-55, wherein the html source document representing the web pages or list data is send through a network and describes the design of a window for displaying on a browser. The list data is stored within the client database).

Regarding Dependent claim 7, Kelley discloses:

- Second storage means for storing image data (See figure 1 & column 4, lines 45-60, wherein the database within the client device represents a second storage means for storing the web pages that inherently include image data);
- Reception means for receiving input information input in accordance with a window displayed by the browser in the client apparatus which can be connected to at least one printing apparatus through a network, and second transmission means for transmitting the image data to the client apparatus on the basis of

the input information received by said reception means (See figure 1 & column 4, lines 45-67, wherein the input information in the window browser displays a print menu that is connected to a printer through a network and transmits the web pages representing the image data).

Regarding Dependent claim 8, Kelley discloses: wherein each of the first list data, the second list data, and third list data lists at least one of information about a model of the printing apparatus, information about a paper size for printing by the printing apparatus, information about a paper type for printing by the printing apparatus, and information about a layout for printing by the printing apparatus (column 2, lines 5-15, wherein the list data represented by multiple lists includes identification information of the printer thereby describing the model of the printer used to select a printer on a network).

Regarding Independent claim 9, Kelley discloses an information processing system in which an information providing apparatus and an information processing apparatus can communicate with each other through a network, wherein the information providing apparatus comprises first storage means for storing first list data, and transmission means for transmitting the first list data stored in the first storage means in accordance with a request from the information processing apparatus, and the information processing apparatus

comprises second storage means for storing a function expansion program for the browser, said function expansion program including acquisition unit adapted to acquire second list data and creation unit adapted to create the information for causing the browser to display a window based on the second list data acquired by the acquisition unit and the first list data received by said reception means (See figure 1 & column 1, lines 45-55 & column 4, lines 45-67, wherein the information providing apparatus includes the network server. The processing apparatus is the client device and is connected through a network. The providing apparatus contains a storage means represented by the database and stores the web pages or list data for transmitting to the client device based on user request. The client device includes the expansion program represented by the plug-in device within the browser used to read various file formats describing the list data).

Regarding Independent claims 10, 11 & 12, Kelley discloses an information processing method in an information processing apparatus which processes information written in a language which can describe design of a window to be displayed by a browser and stores second list data, comprising:

- A reception step of receiving first list data transmitted from another apparatus connected through a network (column 1, lines 45-55, wherein the list data is represented by the printable web pages that are received from another apparatus through a network. The HTML

source file contains the list of printable web pages thereby comprising information written in a language that describes the design of a window so the browser can display the source files representing the list data);

- An acquisition step of acquiring the second list data according to a function expansion program for the browser (column 1, lines 45-55, wherein the second list data or web pages retrieved from the network include an acquisition step for acquiring the list data according to the browser plug-in used to render the list data);
- A creation step of creating information for causing the browser to display a window based on the second list data acquired in the acquisition step and the first list data received in the reception step (column 5, lines 10-30, wherein information is rendered within the browser thereby including a window based on the web pages representing the list data).

Regarding Independent claims 13 & 14, Kelley discloses a function expansion program for causing a computer to process information written in a language which can describe design of a window to be displayed by a browser, wherein the program causes the computer to execute:

- A procedure for acquiring first list data transmitted from another apparatus connected through a network (column 1, lines 45-55,

wherein the list data is acquired by the printable web pages that are received from another apparatus through a network. The HTML source file contains the list of printable web pages thereby comprising information written in a language that describes the design of a window so the browser can display the source files representing the list data);

- A procedure for acquiring second list data from the computer (column 1, lines 45-65, wherein the list data is acquired by the printable web pages that are received from another apparatus through a network. This includes a second list data The HTML source file contains the list of printable web pages thereby comprising information written in a language that describes the design of a window so the browser can display the source files representing the list data); and
- A procedure for creating information for causing the browser to display a window based on the first list data and the second list data (column 2, lines 10-30, wherein the browser renders the window based on the list data described by the web pages according to the HTML source documents).

*It is noted that any citation **[[s]]** to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be*

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limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Conclusion

Other Prior Art Cited

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kirk et al (U.S. Pub 2003/0088518) discloses "Method And System For Secure Printing Via A Web Based Browser"
- Roosen et al (U.S. Pub 2002/0036793) discloses "Remote Printer Control"
- Ihara (U.S. Pub 2001/0025325) discloses "Printing Apparatus, Printing Control Device And Printing System"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

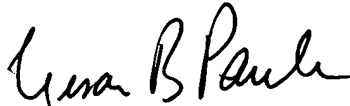
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Manglesh M. Patel

Patent Examiner

December 9, 2005


CESAR PAULA
PRIMARY EXAMINER